

### III. Remarks

#### A. Status of the Application

Claims 1 and 3-35 were pending.

Claims 1 and 5 were rejected.

Claims 3-4 and 6-8 were objected to.

Claims 9-35 were allowed.

Applicant appreciates and acknowledges the allowability of Claims 3-4 and 6-35.

Reconsideration of this application in light of the following remarks is respectfully requested:

#### B. Rejection under 102(b) over U.S. 5,400,857 to Whitby

Claims 1 and 5 were rejected under 35 U.S.C. 102(b) over U.S. Patent No. 5,400,857 to Whitby ("Whitby"). Applicant respectfully traverses the rejection.

Claim 1 recites: "A method of disconnecting one end of a tubing from another end of the tubing, comprising: holding the tubing in a stationary position at a first location and a second location; shearing the tubing at one or more locations between and apart from the first location and the second location to form at least a first section of tubing and a second section of tubing; and moving the first section of tubing away from the second section of tubing."

Whitby does not teach or suggest the desirability of "holding the tubing in a stationary position at a first location and a second location; shearing the tubing at one or more locations between and apart from the first location and the second location to form at least a first section of tubing and a second section of tubing; and moving the first section of tubing away from the second section of tubing," as recited in independent claim 1.

In the Final Office Action, the Examiner stated that Whitby discloses a means for "holding the tubing in a stationary position at a first location 30 and a second location 34...." The Examiner also stated that Whitby discloses a means for "shearing the tubing at one or more locations (at blades 40, 42) between and apart from the first location and the second location to form at least a first section of tubing and a second section of tubing...."

"FIG 1 is a simplified pictorial view, partially in cross-section, of a blowout preventer according to the present invention, with the sealing assemblies associated with each of the opposing lower rams...and with the shearing blades associated with the upper opposing ram assemblies...." (Whitby, column 4, lines 25-31).

Whitby's location 30 and location 34 refer to the lower rams, which are positioned on opposing sides of the pipe P at a single location along the longitudinal axis of the pipe P, as shown in figure 1. Whitby's blades 40 and 42 are associated with the upper rams and are positioned on opposing sides of the pipe P above the single location (30/34), at another location along the longitudinal axis of the pipe P, as shown in figure 1.

Whitby's blades 40 and 42 cut the pipe P at a location apart from the single location, but not between a first and a second location. Furthermore, even assuming *arguendo* that the location 30 and location 34 constitute first and second locations along the longitudinal axis of the pipe P, which they do not, blades 40 and 42 certainly do not cut the pipe P at a location between the lower rams 30, 34. Whitby teaches: "...the blowout preventer apparatus of the present invention includes an upper shear ram and a lower opposed sealing ram. The shearing ram blades initially engage the tub[ing] at four points spaced substantially equidistant about the circumference of the tub[ing], so as to effectively contain the tubular between the blades." (Whitby, column 2, line 40-43, 47-51).

As discussed above, Whitby does not teach or suggest the desirability of independent claim 1.

Dependent claim 5 is allowable for at least the same reasons its respective independent claim 1 discussed above. Applicant respectfully requests that the Examiner withdraw the rejection to claims 1 and 5.

### C. Allowable Subject Matter

Claims 3, 4, and 6-8 were objected to as being dependent upon a rejected base claim. Applicant respectfully traverses. Applicant respectfully submits that claims 3, 4, and 6-8 are all dependent upon allowable independent claim 1, and are allowable for at least the same reasons. Applicant respectfully requests that the Examiner withdraw the objection to claims 3, 4, and 6-8.

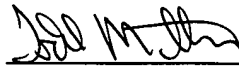
D. Conclusion

In view of the foregoing, Applicant respectfully submits that all pending claims are allowable, and respectfully requests a notice of allowance for claims 1 and 3-35. If the Examiner believes an interview would be helpful in moving the application forward to allowance, or has any questions, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

Date: \_\_\_\_\_

6/3/04



\_\_\_\_\_  
Todd Mattingly  
Registration No. 40,298

HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, TX 75202-3789  
Telephone: 713-547-2301  
Facsimile: 214-200-0853  
H-484351.2